

Appl. No.: 10/712,870
Filed: Nov. 12, 2003
Amdt. dated 07/19/2005

REMARKS

Background Of Office Action

In the Office Action mailed May 2, 2005, the Examiner objected to claim 1 based on a formality, and claim 1 has amended to replace the limitation "host-specific file" with the limitation "host file." Applicant has also amended claim 1 to correct the duplicative antecedent basis for the limitation "a service identifier."

The Office Action rejected claims 1-8, 10-17, and 21 under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Application 2004/0088737, (*Donlan*). The Office Action also rejected claims 9, 18-19, 22-38, and 41-130 as being obvious under 35 U.S.C. 103(a) in light of *Donlan* in view of U.S. Patent Application 2004/0261116 (*McKeown*). Finally, the Office Action rejected claim 20 under 35 U.S.C. 103(a) as being unpatentable over *Donlan* in light of U.S. Patent Application 2002/0178455 (*Poli*).

Rejection of Claims 1-8, 10-17, and 21

It is alleged claim 1 is anticipated by *Donlan*, and specifically that *Donlan* discloses a "processor capable of retrieving a host file using a second interface and deriving a host-specific provisioning message using the host file, the processor capable of transmitting the host-specific provisioning message using a third interface operatively connected to a digital communication network wherein the digital communication network is further connected to a host."

Applicant respectfully disagrees, as *Donlan* fails to disclose a "host file", nor does it disclose "deriving a host specific provisioning message using the host file."

The present specification describes the host file as comprising information used to communicate with a specific host. When the Enhanced Services System (ESS) transmits a configuration message to a host, the ESS needs to know how to 'speak' with a particular host. The ESS can access a host file, which is associated with that host type, and determine how to communicate with that particular host. Thus, the host file can be used to produce or derive data

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that is understood by a specific host. For example, as recited in claim 1, the "the processor [is] capable of retrieving a host file using a second interface and deriving a host-specific provisioning message using the host file." This allows the processor to communicate with a host, which the processor would otherwise be unable to communicate with. The host file can comprise various types to facilitate communication with a host for configuring it, and throughout the specification, various examples are provided. For example, the present specification states:

The Host File Database (HFD) functions as a master repository for host-specific files. The HFD contains various types of files that are associated with a given type of host, the type of host determined by a manufacture and model identifier. The files can contain data used for a variety of purposes, including software patches, replacement operating systems, application code updates, configuration data, application level data, protocol handlers and device capability descriptions. The host files can be generally classified into four categories. First, there are host profile files that describe attributes of the host. These are used by the configuration message set creation system to drive a user-interface. Second, there are the host protocol files that are used to create the individual messages in the configuration message set. Third, there are host data files that may contain software patches, service data, application, or any other form of host-specific software. Finally, there may be configuration message set files. The first three file types are provided from the host manufacturer to the HFD, which are downloaded in turn to the ESS. The last type (configuration message set) is typically created by the cable system operator using the configuration message set creation system. (Specification, pages 110, 111.)

The Office Action recognized that *Donlan* does not send any messages to a host (Office Action, page 7, lines 15- 16, page 8, line 8). Therefore, it would not make sense for *Donlan* to store a host file, which contains data used in communicating with a host. Although Figure 4 of *Donlan* discloses a database schema, it can only be concluded that the schema is not used for communicating with a host. Therefore, Figure 4, and the associated text in paragraph 0043 do

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not disclose a "host file." In summary, *Donlan* does not disclose "host files," because host files are used to communicate with a host and *Donlan* does not communicate with a host.

Although *Donlan* discloses various types of database schemas in Figure 4, it is not clear whether these are separate files or data structures (e.g., elements within a record) within a single file. It is presumed the database schema in *Donlan* is used to accomplish provisioning in the various network elements. As stated in the office action, "the patent [*Donlan*] is exclusively used to teach the logistics of the provisioning system before the headend and distribution to a client." (Office Action, page 8, lines 11-12). Thus, the database scheme in Figure 4 of *Donlan* only pertains to provisioning of elements in the headend. It does not follow, then, that the schema discloses a "host file."

An analogy may be relevant. A telephone can signal by using dial-pulses (e.g. as used by the older rotary dial phones) or touch-tones. Typically, phones have a switch that the user can select, although most users today prefer to use touch-tone. Similarly, a telephone central office (a.k.a. telephone switch) can be provisioned to accept only dial pulse for a subscriber, or both dial pulse or touch tone signaling. When provisioning telephone service, the telephone company must store information about which option the subscriber selected in order to provision the telephone switch. However, the telephone company does not send any messages to a customer's telephone configuring it for dial pulse or touch tone signaling. Nor would the telephone company maintain any data about, for example, what protocol messaging are used for sending configuring message to the telephone, since no configuring messages are sent to the telephone. Similarly, it is not surprising that *Donlan* discloses a database schema for maintaining information in order to properly provision network elements, but that information does not indicate mean that messages are sent to a host, much less a host file indicating how to communicate with a device.

Applicant has also amended claim 1 to better state the invention. Claim 1 was initially drafted without explicitly reciting the processor transmits the host-specific message to the host. Claim 1 now is amended to state "the processor capable of transmitting the host-specific

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provisioning message to a host...” Applicant has not made this narrowing amendment in response to overcoming the *Donlan* reference, as *Donlan* does not recite a “host file.” Applicant notes that in the Office Action, it is admitted by that “*Donlan* fails to specifically teach transmitting a provisioning message to a host using a second interface.” (Office Action, page 8, lines 8-9.) Consequently, Applicant submits that Claim 1 is patentable over *Donlan* by virtue of reciting a “host file” which *Donlan* does not disclose.

Applicant submits that other limitations in claims 2-8, 10-17, and 21 are not disclosed by *Donlan* as alleged in the Office Action. However, because these claims depend from claim 1, and because the “host file” limitation is incorporated in each of the dependent claims, which is not disclosed by *Donlan*, Applicant respectfully submits claims 2-8, 10-17, and 21 are also allowable over *Donlan*. For the sake of brevity, Applicant sees no need at this time to discuss the individual limitations of each dependent claim in light of *Donlan*.

Rejection of Claims 9, 18-19, 22-38, and 41-130

Applicant notes that claim 22 has been amended, not in light of the prior art, nor in light of the rejection in the Office Action, but to correct inconsistent usage of limitations. Specifically, “transmitting a *provisioning message* to a host” has been amended to recite “transmitting *at least one configuration message* to a host” to align the terminology used in the subsequently recited “memory storage” element which is capable of storing the host file comprising the at least one configuration message.

Applicant has also amended claim 118 to better state the invention, namely: that the “determining in the enhanced services server a host file for use in deriving a provisioning message” to emphasize that the enhanced services server uses a host file to derive the provisioning message.

The above claims are rejected based on the combination of *Donlan* and *McKeown*. Applicant contends that the combination of the two references is inappropriate as it fails to teach or suggest all of the limitations recited in the claims.

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All of the above claims, as now amended, recite the limitation of a "host file." As discussed above, *Donlan* does not disclose sending messages to a host, and thus *Donlan* does not disclose a host file. For this reason alone, the combination of *Donlan*, with any other reference, such as *McKeown*, wherein *Donlan* is relied upon for the proposition of disclosing a "host file," does not render obvious the claims, because not all of the limitations are taught by the combination. As stated in the MPEP 213.03, "To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. ...If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious."

The Office Action combined *Donlan* with *McKeown*. The *McKeown* reference is cited for the proposition that it discloses transmitting provisioning messages, presumably, to a host. In support of this, the Office Action cites paragraphs 0098, 0422, and 283 of *McKeown*.

McKeown is a lengthy reference, and focusing on selected portions of text may provide an incomplete representation of what *McKeown* discloses. A closer reading of *McKeown* shows that these citations do not support the proposition that provisioning messages are sent to a host.

First, paragraph 98 precedes the Detailed Description, and appears to be a section of text describing the objects and selected aspects of the invention. The invention is described as a "provisioning tool" that "has means for receiving an identifier of a client device and means for selecting an activation script based on the identifier. The identifier may include an identifier of equipment type.... This is particular beneficial when scripts govern workflow as the workflows for a variety of similar devices from different manufacturers may be similar or identical but the precise activation actions may differ...."

This section does not state messages are sent to a host. This states a characteristic of the provisioning tool, not how it works. To fully understand, the paragraphs in the Detailed Description need to be consulted. However, Applicant notes that the term "workflow" in terms of provisioning is well understood in the art to pertain to typically mean managing a sequence of events in various network elements that are to provision a service. Furthermore, examining of

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the preceding paragraphs (par. 95-97) indicates that the "script" referenced pertains to a workflow sequence dependent on the various hardware devices or services. The text does not state that messages are sent to a host for provisioning.

The first paragraph in the detailed description of *McKeown* that the Office Action references for supporting the proposition that messages are sent to a host is paragraph 283. Paragraph 283 is the last step of a process (Step E), and states:

"Provisioning is carried out as required, using the MAC address obtained to enable provision of the new service to the user (Step 230) via the relevant access device; the remainder of the provisioning process may correspond to or be based on a known provisioning process." (*McKeown*, page 14, par. 283)

According to Figure 2, there is a line 230 disclosed with the caption "New Service To User." Applicant notes that the cited text, on its face, does not disclose a processing transmitting a provisioning message to a host. Further, it appears that the reading of the text is that once the MAC address is obtained, the new service can be provided to the user via the user's access device (e.g., cable modem). Nothing states that configuration messages are sent to a host. Rather, it appears, once the network has the MAC address, the appropriate network elements for provisioning the new service can be configured and the user is able to use their new service (using of course, the access device). It appears the "normal provisioning" process is similar to *Donlan*, in that messages are sent to network elements to provision a service.

In reviewing the text prior to Step E (namely paragraphs 271 – 283), it appears a main focus of the invention is defining a procedure for a service provider to obtain the MAC address so that additional services can be provisioned. It appears the additional services are provisioned, as stated in Step E, "as required." Nothing in this text indicates host-specific messages are sent to the host.

The next paragraph in the Detailed Description cited for the proposition that provisioning messages are sent to the host is paragraph 422. First, paragraph 422 must be read in context of

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paragraphs 420-422. This section pertains to *testing*, not provisioning. Typically, testing is performed to determine or isolate a fault that occurs *after* a service is provisioned. Specifically, testing typically occurs after provisioning has failed. It is unclear how a testing a service can be performed before the service is provisioned. Nor is it clear why testing would occur after the service is provisioned, if the service is operational. Because testing and a different process than provisioning, this alone renders the section as inapplicable.

Second, paragraph 421 explains testing is accomplishing by *installing* a personal computer as a testing platform. The personal computer is used to launch *test signals into* the network. [“According to a further aspect of the present invention, there is provided a method of testing a broadband network...”, *McKeown*, page 20, par. 420, lines 3-4.] Thus, the paragraph cited for the proposition that configuration messages are sent to a host actually pertains to testing a broadband network by installing a testing device (personal computer) and sending test signals into the network to receive a response. Applicant respectfully submits that this does not disclose sending configuration messages to a host. It discloses, at most, a personal computer programmed for “launching a test signal to the network and ... monitoring a response by the network...” (*McKeown*, page 20, par. 420, lines 12-13.) Applicant respectfully submits that this is distinct from provisioning, and that no provisioning messages are sent to the host.

Applicant submits that the combination of *Donlan* and *McKeown* is deficient because *Donlan* does not disclose “host files” and *McKeown* does not disclose transmitting provisioning messages to the host. Further, there is no disclosure teaching or suggesting that *McKeown* would generate any host specific messages based on a host file and transmit them to the host. Therefore, it appears the rejection of Claims 9, 18-19, 22-38, and 41-130 is inappropriate, since the combination of *Donlan* and *McKeown* does not render obvious the claim limitations.

Rejection of Claim 20

The Office Action rejected claim 20 based on the combination of *Donlan* in view of U.S. Patent Application 2002/0178455 (“*Poli*”). *Poli* is cited for the proposition that an out-of-band channel is used for transmitting information to a host.

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Claim 20 depends from claim 1, which recites a "host file." The Office Action relies on *Donlan* for the proposition that it discloses a "host file." As previously stated, *Donlan* does not disclose "host file" because *Donlan* does not send messages to a host. Therefore, the reliance of *Donlan* in combination with *Poli* is deficient to anticipate all the limitations in claim 20. Although *Poli* discloses communicating messages to a host, *Poli* does not disclose a "host file."

Conclusion

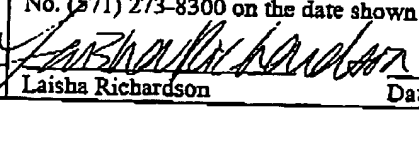
Applicant appreciates the thorough response provided by the Examiner. Applicant notes, however, that none of the art cited discloses a "host file," nor using a host file to derive a host-specific message and transmitting it to a host. Applicant considers the present response as complete and addressing all of the claim rejections. Applicant respectfully submits the rejection for all claims be withdrawn, and that all claims be placed in a condition of allowance.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,



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